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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/674,058   | 09/29/2003  | Stewart Young        | 4002-3427/PC463.05  | 1188             |
| 30565  | 7590        | 07/11/2006           | EXAMINER            |                  |
| WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP<br>111 MONUMENT CIRCLE, SUITE 3700<br>INDIANAPOLIS, IN 46204-5137 |             |                      | PHILOGENE, PEDRO    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3733                |                  |

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

# Office Action Summary

Application No.

10/674,058

Applicant(s)

YOUNG, STEWART

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,626,906. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the elements of claims 21-30 are to be found in claim 1-20. The difference between claims of the application and claims of the patent lies in the fact that the application claims contain functional language recitation. It is noted that the manner, in which a device is intended to be employed, does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte marsham, 2 USPQ2d 1647 (1987). Since claims of the patent are capable of performing the function as claimed in the application, the claims of the application are anticipated by the claims of the patent.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21,22,25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (5,575,791).

With respect to claim 21, Lin discloses a spinal implant system comprising a vertebral anchor (60) having a shank with a first unthreaded portion, a spinal implant rod (50) having a second unthreaded portion; a compressible ring (30), the compressible ring defining an aperture capable of receiving the unthreaded portion of the of the spinal implant rod, a clamp (10) the clamp having first and second arms, the first arm having a first channel and the second arm having a second channel, as best seen in FIG.1a, a collet (40), the collet positioned inside the first and second channels of the clamp, the collet defining a socket capable of holding the unthreaded portion of the vertebral anchor; wherein the collet is adjustably anchorable among a plurality of positions along the length of the first unthreaded portion of the anchor, the ring is adjustably anchorable among a plurality of positions along the length of the second unthreaded portion of the rod. Considering the clamp as one piece, moving the nut (43) on the threaded portion of the collet would adjust the collet on the rod in a plurality of positions thereby adjust the ring on the anchor in a plurality of positions.

With respect to claims 22, 25-30, Lin discloses all the limitations, as set forth in column 4, lines 10-67, column 5, lines 1-8; and as best seen in FIGS. 1-6.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (5,575,791) in view of Yoshimi et al. (6,030,388).

With respect to claims 23,24, it is noted that Lin did not teach of a clamp having a straight internal taper and a collet having a straight outside taper, as claimed by applicant. However, in a similar art, Yoshimi et al evidence the use of a clamp with internal taper and a collet with outside taper to prevent further insertion of the collet into the channel of the clamp.

Therefore, given the teaching of Yoshimi et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Lin, as taught by Yoshimi et al., to prevent further insertion of the collet into the channel of the clamp.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,565,569

5-2003

Assaker et al.

Art Unit: 3733

5,938,663

8-1999

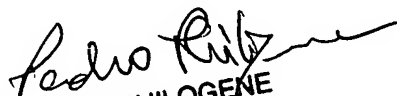
Petreto

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
July 06, 2006

  
PEDRO PHILOGENE  
PRIMARY EXAMINER